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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,482	01/16/2004	Christopher J. Moriarty	WUR 50874/USw	7583

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EXAMINER

ZIMMER, MARC S

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/759,482

Applicant(s)

MORIARTY, CHRISTOPHER J.

Examiner

Marc S. Zimmer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-21 is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 01/16/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Analysis

Applicant is advised that the term "release" is interpreted merely as being a recitation of intended use as in a, "composition for imparting release properties".

Section 2112.02 of the MPEP provides direction as to how phrases such as this are to be treated: "If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). See also *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) ("where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation"); *Kropa v. Robie*, 187 F.2d at 152, 88 USPQ2d at 480-81 (preamble is not a limitation where claim is directed to a product and the preamble merely recites a property inherent in an old product defined by the remainder of the claim). Insofar as the emphasized term fails to satisfy the criteria set forth above, it is not assessed any measure of patentable weight.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7 and 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Nguyen et al., U.S. patent # 4,742,144. Nguyen discloses a release agent for the process of making molded lignocellulosic composites is taught wherein said agent is derived from a polydiorganosiloxane bearing hydroxyl- or carboxylic acid groups and a monocarboxylic acid adhering to the formula in column 2, line 57. Among the acids particularly mentioned as being suited to the invention are lauric acid, oleic acid, lineoilic acid, etc. According to the formulaic representation of the silicone component, as many as 20 repeat units of the polymer may be functionalized with the aforementioned hydroxyl or carboxylic acid moieties. These materials are reacted in a 1:1 ratio according to example 1 in a medium selected from aliphatic or aromatic hydrocarbons and, further, the product may be dissolved in these for future application.

Contrary to what the Examiner had asserted in the national phase application of which this Application is a continuation, claims 17 and 18 are not anticipated Nyugen because the carboxylic acid and polysiloxane are reacted together prior to being applied to the caul plates of the lignocellulosic article-forming apparatus. Also, is important to note that, although Nguyen also contemplates preparing the release agent for

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application as a water emulsion, the materials have already been reacted. That is, the carboxylic acid and active-hydrogen-containing polysiloxane are apparently reacted prior to the incorporation of the polymer into an aqueous solution. Because the acid and polymer no longer exist as discrete materials, claims 8, 9, and 13-15 are not anticipated by the reference.

Claims 1-3, 5-11, 13, and 15-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Ona et al., U.S. Patent # 4,973,620. Ona discloses a fabric treating composition comprising an aminoalkyl group-functionalized linear polysiloxane and a carboxylic acid adhering to the formula presented in column 2, line 48. It is notable that where the sum of $b/2$ and the number of carbon atoms in R^2 is higher than 5, the structural limitations of component (a) of Applicant's invention are satisfied. According to column 3, lines 9-15, the carboxylic acid is added in an amount such that 0.2 to 5 moles of acid groups are contributed for each mole of amino groups in the polymer. These materials may be dissolved in any of the organic diluents mentioned in column 3, lines 20-25 or, alternatively, may be dispersed in water containing a cationic or nonionic surfactant such as, for instance, alkyl phenol ethers.

The polymer displayed in Example 1 fulfills the limitations of claim 5.

Claims 1-3, 5-9, 11-13, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Maruyama et al., U.S. patent # 5,726,241. Maruyama discloses in the abstract a finishing composition for coating carbon fibers comprised of

(i) 0.2 to 10 parts of a carboxylic acid salt of an amine, and

(ii) a finish composition containing

- (a) an aminoalkyl-functionalized polysiloxane (up to 2.0 wt.% amino groups),
- (b) a carboxylic acid having six carbons or less made available in a quantity representing 0.3 to 5 equivalents per amine group in (a), and
- (c) a nonionic emulsifier.

Water is added as a solvent yielding a solution that is transparent to the naked eye.

Claims 1-10 and 13-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Leboucher et al., U.S. Patent # 6,475,974. The abstract discloses emulsions formulation using water, surfactant, a non-volatile linear polysiloxane oil, an amine-functionalized polysiloxane, and a carboxylic acid. A formulaic representation of the amine-functional polysiloxane is provided in column 3 where it is disclosed that the average number of repeat units bearing amine moieties is 0 to 100 (column 3, lines 31-33). Exemplary carboxylic acids including myristic acid and lauric acid are mentioned in column 5, lines 20-27. Fatty alcohol ethoxylates are recited as suitable embodiments of the surfactant in column 4, lines 34-35.

Allowable Subject Matter

Claims 17-21 are allowable. Nguyen et al., represents perhaps the most relevant prior art for their disclosure of a carboxylic acid-modified polysiloxane as an internal release agent for manufacturing lignocellulosic composite articles. In fact, the invention taught therein departs from the instant invention only in that the polysiloxane bearing active hydrogen atoms is reacted with the carboxylic acid prior to being employed as

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release agent. Contrast this with Applicant's invention where the polysiloxane and carboxylic acid form an unreacted mixture to be used both as an internal release agent and a release agent that is applied to the plates of the pressing apparatus.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 16, 2005

Marc Zimmer

Marc Zimmer

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